

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS P. MARQUIS

Appeal No. 2001-0213
Application No. 08/884,146

ON BRIEF

Before PAK, WARREN and JEFFREY T. SMITH, *Administrative Patent Judges*.
JEFFREY T. SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicant appeals the decision of the Primary Examiner finally rejecting claims 1 to 3 and 5, all of the claims present in the application. We have jurisdiction under 35 U.S.C. § 134.¹

¹ In rendering our decision, we have considered the Appeal Brief filed December 20, 1999.

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BACKGROUND

According to Appellant, the invention relates to a food preportioning bag of the type used in food handling facilities such as a restaurant. (Brief, p. 2). Claim 1, which is representative of the claimed invention, appears below:

1. A preportioning bag used in food operations wherein a bulk food supply is divided into portions of smaller size, individual portions are located in a bag, and the bag is closed for use at a later date, said bag defining exposed side walls, and printing on at least one side wall, said printing comprising at least several days of the week, said printing comprising a plurality of separate printed blocks positioned closely adjacent each other, each day being printed within a separate block, and wherein each day is printed in a different color.

CITED PRIOR ART

As evidence of unpatentability, the Examiner relies on the following references:

Esty	2,201,524	May 21, 1940
Plakas	2,685,860	Aug. 10, 1954
Brumley	3,205,603	Sep. 14, 1965
Wolf	3,392,468	Jul. 16, 1968
Kramer et al. (Kramer)	3,818,858	Jun. 25, 1974
Fear	4,630,733	Dec. 23, 1986
Jensen (Jensen '780)	4,733,780	Mar. 29, 1988
Clement	5,195,123	Mar. 16, 1993
Jensen (Jensen '273)	5,690,273	Nov. 25, 1997
Tenner et al. (Tenner)	5,642,605	Jul. 01, 1997

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Hain
(Published French Patent Document)

FR 877649

Dec. 11, 1942

Creyaufmuller²
(Published European Patent Application)

EP 0426963 A1

May 15, 1991

The Examiner rejected claims 1 to 3 under 35 U.S.C. § 103(a) as being unpatentable over Tenner in view of Esty, Creyaufmuller, Yuen, Hain, Plakas, Brumley, Fear, Jensen ‘273, Wolf and Clement. (Answer, p. 3). The Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Tenner in view of Esty, Creyaufmuller, Yuen, Hain, Plakas, Brumley, Fear, Jensen ‘273, Wolf and Clement, as applied to claim 1, and further in view of Jensen ‘780. (Answer, p. 8).

The Appellant submits that “[c]laims 1-3 and 5 stand or fall together as one group.” (Brief, p. 5). Accordingly, all the claims will stand or fall together. We will limit our consideration to claim 1, the sole independent claims, as representative of all of the claims on appeal from that group. 37 CFR § 1.192(c)(7)(1997).

DISCUSSION³

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the Examiner and Appellant in support of their

² The Examiner refers to this document as Melitta in the Answer.

³ In rendering our decision we do not find it is necessary to provide a discussion of the Esty, Creyaufmuller, Yuen, Hain, Plakas, Brumley, Fear, Jensen ‘273, Wolf, Clement, and Jensen ‘780 references.

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respective positions. This review leads us to conclude that all of the Examiner's § 103 rejections are well founded. Our reasons for this determination follow.

Rather than reiterate the respective positions advanced by the Examiner and Appellant, we refer to the Examiner's Answer and to Appellant's Brief for a complete exposition thereof.

The Tenner reference discloses a portion inventory bag that renders the claimed subject matter unpatentable. Tenner discloses a portion inventory device for holding at least one portion of food. The device uses a plastic bag for holding the portions and the bag has indicia of predetermined dates or days imprinted on the outer surfaces of the bag. (Col. 3, ll. 21-23). Tenner discloses the indicia of the predetermined days/dates may use one of a plurality of different colors to correspond to the one of the plurality of predetermined days/dates. (Col. 3, ll. 33-37). Further, Tenner discloses the indicia for the predetermined days/dates may be expressed in a plurality of languages or displayed in a variety of patterns and styles. (Col. 3, ll. 38-46).

Appellant's arguments have all been considered and are not persuasive. Appellant argues the distinction of the claimed invention over the prior art resides in the printing on the bag. Specifically, Appellant argues claim 1 recites that the printing consists of plurality of days in a block display and each day is printed in a different color. (Brief, p. 8).

Because the sole distinction between Tenner and the claimed invention is in the printed matter, there being no new physical structure and no new relation of printed matter

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to physical structure, such claims are not patentable. *In re Montgomery*, 214 F.2d 136,139, 102 USPQ 248, 250 (CCPA 1954).

To the extent that we rely on Tenner alone to establish the *prima facie* case, we do not consider the rejection over Tenner alone to constitute a “new ground” of rejection. The issue, in this respect, is whether Appellants have had a fair opportunity to react to the thrust of the rejection. *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Limiting the discussion to the evidence contained in Tenner while using the same basis and teachings as the Examiner relied upon does not constitute a new ground of rejection. *See Kronig*, 539 F.2d at 1303, 190 USPQ at 427; *In re Bush*, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961).

The Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Tenner in view of Esty, Creyaufmuller, Yuen, Hain, Plakas, Brumley, Fear, Jensen ‘273, Wolf, and Clement, as applied to claim 1, and further in view of Jensen ‘780. Appellant has indicated that all claims stand or fall together and have not presented an argument directed to this claim. Consequently, we will uphold the Examiner’s rejection of claim 5 for the reasons stated above.

CONCLUSION

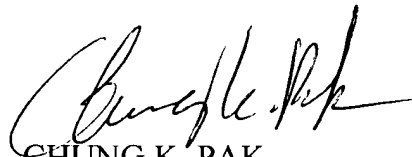
For the foregoing reasons, all of the Examiner’s rejections of claims 1 to 3 and 5 under 35 U.S.C. § 103(a) are affirmed.

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Time for taking action

No time period for taking any subsequent action in connection with this appeal may
be extended under 37 CFR § 1.136(a).

AFFIRMED



CHUNG K. PAK
Administrative Patent Judge



CHARLES F. WARREN
Administrative Patent Judge



JEFFREY T. SMITH
Administrative Patent Judge

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